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09/766,696	01/19/2001	Kazuhiro Fujii	SIC -00-004	9689
29863	7590	09/13/2005	EXAMINER	
DELAND LAW OFFICE P.O. BOX 69 KLAMATH RIVER, CA 96050-0069			BOEHLER, ANNE MARIE M	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/766,696

Filing Date: January 19, 2001

Appellant(s): FUJII, KAZUHIRO

James Deland
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 27, 2005 appealing from the Office action mailed October 7, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is substantially correct. The rejection of claims 17 and 18 is hereby withdrawn. Claims 17 and 18 are allowable over the prior art of record.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,681,234	Ethington	10-1997
4,599,079	Chappel	7-1986

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-16, 66,67, 69, 77-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ethington in view of Chappell.

Ethington shows a base for actuator 50 including an upper flat surface of the bottom wall surface and vertical walls supporting a load thereon. It also includes pair of brackets. The brackets are connected to the angled down tube rather than a horizontal chain stay.

Chappell shows a support for a transmission actuator including two brackets connecting the actuator to a chain stay.

It would have been obvious to one of ordinary skill in the art to mount the Ethington control device to the chain stay, as taught by Chappell, in order to mount the controller proximate the sensing device, for a more compact arrangement.

(10) Response to Argument

Applicant argues that there is no motivation to position the Ethington power unit on the chain stay, as taught by Chappel, because it would provide little benefit and would not be more compact in that more cable would be needed to connect the manual shift levers to the actuators. The examiner disagrees. Ethington describes a retrofit for an existing bicycle. The bicycle will already have cables connecting the manual shifters to the front and rear derailleurs. Therefore, neither a significant amount of additional cable, nor greater complexity or exposure of cable will be required if the automatic shift actuation unit is positioned on the chain stay. Also, positioning the actuators and sensor together allows for fewer mounting brackets, and consolidated wiring running to

the controller 72 for easier assembly at the time of the retrofit. Therefore, the rejection is being maintained.

Applicant argues that the Ethington bracket base is not dimensioned for supporting the control device such that the control can be removed as a unit from the bracket base. The examiner disagrees. The ability of the motor to be removed as a unit is a function of the motor design not the support. As claimed, the base simply needs to be configured to or capable of allowing the control device to be removed as a unit. That is the case with Ethington. The motor of Ethington is not specifically disclosed as being removable as a unit; however, the appellant does not claim the motor. Appellant claims a bracket base capable of supporting a control unit such that the control unit can be removed as a unit. Ethington need not teach a control unit of any kind. The invention is the bracket base. Any structure capable of performing the function would meet the claim language, including the structure taught by Ethington.

Regarding the amendment to claim 66, "wherein the upper surface does not form part of the control device", this claim language is believed to be met by the combination. In Ethington, the upper surface is part of a support structure, not part of the control device (motors 48, 54). The brackets and base do not perform any control function and do not constitute an integral part of the control device. They are merely the support for the control device.

Claims 3 and 4

Chappel shows the brackets that attach to the bicycle frame being offset from the centerline of the base because the seat stays are laterally offset.

Claim 5

Chappel shows at least one bracket support extending from a lateral side of the base to accommodate the lateral offset of the chain stay.

Claims 7-10

Ethington shows, in Figure 5, at least one central wall extending up from the base for mounting motor 112 and at least one end wall extending from the base for supporting the motor.

Claim 14

The bracket supports of Ethington, unnumbered but shown in Figure 1, conventionally are secured by some form of threaded fastener. Therefore, it would have been conventional to provide a threaded hole to receive the fastener to secure the bracket support to the frame.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

 9/6/05
Anne Marie Boehler

Conferees:

Lesley Morris LM

Kevin Hurley KH

J